

Remarks/Arguments

This Communication is in response to the Office Action dated 15 October 2004.

Independent Claim 1 has been amended to recite that the promotingly effective metal M is zinc. Thus the claimed catalyst composition consists of palladium and nickel carried on a support which composition contains a promotingly effective amount of zinc.

Claim 1 was rejected under 35 USC 102(b) as being anticipated by US 6,350,717 (Frenzel). Frenzel is deficient with respect to any teaching or suggestion of the catalyst composition as defined in amended Claim 1 which requires both palladium and nickel on a support and a promotingly effective amount of zinc. Applicant submits that Frenzel neither teaches nor suggests the claimed subject matter of amended Claim 1. The claim now recites that the catalyst composition consists of nickel and palladium on a support having a promotingly effective amount of zinc and specifically excludes one or more metals of the 11th group of the Periodic Table of Elements, i.e., copper, silver and gold, in the amounts as required by Frenzel.

In view of the above, Applicant requests reconsideration of this anticipation rejection based on Frenzel and its withdrawal.

Claims 1-7 were rejected under 35 USC 102(b) as being anticipated by US 5,990,344 (Couves). As with Frenzel, Couves is deficient with respect to any teaching or suggestion of the catalyst composition as defined in amended Claim 1 which requires both palladium and nickel on a support and a promotingly effective amount of zinc. As the Examiner has recognized, Couves only requires the catalyst contain palladium whereas the catalyst may also contain gold, copper, and/or nickel as promoters as well as additional promoters like cadmium. In fact, Couves does not teach or suggest the presence of zinc as a promoter. The Examiner has admitted this in her next rejection of Claims 8-10 as being unpatentable under 103(a) over Couves in view of Frenzel. Thus, Couves neither teaches nor suggests the presently pending claims.

In view of the above remarks, Applicant requests reconsideration of this anticipation rejection based on Couves and its withdrawal.

Claims 8-10 are rejected under 103(a) as being unpatentable over Couves in view of Frenzel.

Applicant submits that this obviousness rejection is untenable in that the combination of references as relied upon by the Examiner neither teaches nor suggests the claimed subject matter as a whole. Couves does not teach or suggest the presence of zinc as a promoter. Simply because Couves and Frenzel have teachings and suggestions with regard to catalyst compositions comprising some similar components as either mandatory components or optional components does not mean that the teachings of the two can be combined as the Examiner has done.

A worker skilled in the art would recognize that Couves teaches a catalyst composition for making vinyl acetate from ethylene, acetic acid and an oxygen-containing gas. The catalysts taught by Frenzel are used for the selective hydrogenation of unsaturated compounds in hydrocarbon streams. These are two completely different reaction processes. A worker skilled in the catalyst art does not conceive or make a catalyst in the abstract but does so with a particular reaction in mind. The fact that Frenzel may suggest the optional use of zinc as a promoter in its compositions for hydrogenating unsaturated compounds in hydrocarbon streams would not motivate a skilled worker developing a catalyst for making vinyl acetate to add zinc as a promoter.

Nevertheless, the present application shows that the addition of promoting amounts of zinc provides for a surprising and unexpected suppression of the formation of lights and tars in DNT hydrogenation as shown in Example 4.

In view of the above remarks, Applicant requests reconsideration of the 103(a) rejection based on Couves in view of Frenzel and its withdrawal.

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Believing the application is now in condition for allowance, Applicant solicits an action to that effect.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael Leach", written in a cursive style.

Michael Leach
Attorney for Applicant
Registration No. 27,349

7201 Hamilton Boulevard
Allentown, PA 18195-1501
(610) 481-8519